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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,430	03/29/2001	Mitchell M. Jackson	3085R	5042

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THE LUBRIZOL CORPORATION  
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EXAMINER

TOOMER, CEPHIA D

ART UNIT PAPER NUMBER

1714

DATE MAILED: 09/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/820,430

Applicant(s)

JACKSON ET AL.

Examiner

Cephia D. Toomer

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 6/19/06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 19 and 33-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19 and 33-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

This Office action is in response to the statement of common ownership and remarks filed June 19, 2006. The previous rejections are withdrawn in view of the statement of common ownership.

#### ***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 19, 33-38, 40 and 42 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-23 of U.S. Patent No. 6,224,642 in view of JP 58117282, Jung (US 5,503,645) and EP 869163.

Daly teaches a fuel additive that is useful in improving fuel economy and reducing engine wear by enhancing the lubricity properties of fuels such as diesel, and gasoline. The additive may comprise a polyetheramine and a mixture of fatty acid

Art Unit: 1714

esters and alkoxylated amines. The polyetheramine is prepared in substantially the same manner as the polyetheramine of the present invention (see abstract; col. 1, line 5-19; col. 2, lines 3-4). The alcohols useful in making the esters include polyhydric alcohols such as ethylene glycol, and glycerol (see col. 5, lines 48-51; col. 6, lines 4-10). The fatty acids used in preparing the esters contain from 8-22 carbon atoms (see col. 3, lines 31-33). The fatty acid ester is preferably a partial fatty acid ester of a polyhydric alcohol such as glycerol monooleate (see col. 6, lines 12-29).

The alkoxylated amines are of the formula set forth at col. 6, lines 30-35, wherein  $R^1$  is an alkyl or alkenyl group having about 14 to about 30 carbon atoms,  $R^2$  and  $R^3$  are vicinal alkylene groups and each  $x$  and  $y$  is an integer of at least 1, the total of  $x$  and  $y$  being about 6 or less (see col. 6, lines 38-43).

Daly teaches that conventional additives may be included in the fuel additive composition. The additive composition may be diluted with a normally liquid organic diluent such as benzene, toluene and xylene to form a concentrate. The concentrate contains from about 10-90% by weight of the additive (90-10% by weight solvent) and may contain one or more conventional additives (see col. 7, line 63 through col. 8, lines 1-3). Daly teaches the limitations of the claims other than the differences that are discussed below.

In the first aspect, Daly differs from the claims in that he does not specifically teach the addition of 0.001-10% by wt of a pour point depressant. However, JP teaches this difference in that it teaches a fuel composition comprising an ethylene vinyl acetate pour point depressant. See abstract in its entirety.

Art Unit: 1714

It would have obvious to one or ordinary skill in the art to add a pour point depressant to the gasoline additive concentrate because Daly teaches that the fuel of his invention may contain other additives which are well known to those of skill in the art (see col. 7, lines 50-52) and JP teaches a conventional pour point depressant that is added to a gasoline composition such as that of Daly.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to optimize the proportions of the pour point depressant through routine experimentation for best results. As to optimization results, a patent will not be granted based upon the optimization of result effective variables when the optimization is obtained through routine experimentation unless there is a showing of unexpected results which properly rebuts the *prima facie* case of obviousness. See *In re Boesch*, 617 F.2d 272, 276, 205 USPQ 215, 219 (CCPA 1980). See also *In re Woodruff*, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936-37 (Fed. Cir. 1990), and *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

In the second aspect, Daly differs from the claims in that he does not exemplify an additive composition wherein both the partial ester and alkoxylated amine are present. However, it would have been obvious to one or ordinary skill in the art to have combined these two components because Daly teaches that component (B) may be a mixture of two or more of the compounds that may be used as component (B).

Daly fails to teach that the concentrate composition is a liquid at a temperature from about 0 to minus 18 °C. However, since Daly has set forth that all of the recited components of his invention may be present in his fuel additive concentrate and he

Art Unit: 1714

teaches all of the claimed components, it would be reasonable to expect that the additive concentrate of his invention would be a liquid at a temperature from 0 to minus 18 °C.

Daly and JP have been discussed above. JP fails to teach that the pour point depressant is a terpolymer of a dialkyl fumarate, a vinyl carboxylate and a vinyl ether. However, Jung teaches a fuel composition wherein the pour point depressant is either ethylene vinyl acetate copolymer (EVA) or a terpolymer of dialkyl fumarate-vinyl ester-vinyl ether (see abstract; col. 2, lines 20-26; col. 4, lines 3-12).

It would have been obvious to one of ordinary skill in the art to replace EVA with a terpolymer of dialkyl fumarate-vinyl ester-vinyl ether because Jung teaches that these polymers are equivalent for the purpose of reducing the pour points of fuel compositions.

Daly has been discussed above. Daly fails to teach the specifics regarding the ashless dispersants. However, EP teaches a fuel composition comprising an alkoxylated fatty amine as in the present claims and in Daly in combination with at least one nitrogen detergent such as those of the present invention (see abstract; page 3, lines 1-48).

It would have been obvious to one of ordinary skill in the art to include the nitrogen containing detergents because Daly teaches that his composition may contain ashless dispersants and EP teaches that the ashless dispersants polyetheramine, polyalkyleneamine and Mannich bases are conventional dispersants that are combined

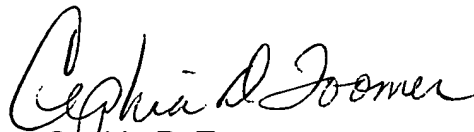
Art Unit: 1714

with alkoxylated fatty amine to impart reduced friction in the operation of an internal combustion engine.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cephia D. Toomer whose telephone number is 571-272-1126. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Cephia D. Toomer  
Primary Examiner  
Art Unit 1714

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